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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CECILY ANNE SNYDER

Appeal 2008-1228
Application 09/996,341
Technology Center 3600

Decided: August 8, 2008

Before HUBERT C. LORIN, LINDA E. HORNER, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Cecily Anne Snyder (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-3 and 5-26. Claim 4 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The Appellant's invention relates to a method for managing legal cases and particularly patent applications. Specification [09] and [18]. In particular, the invention pertains to a docketing method for cases whereby a message is generated upon receipt of a signal indicative of an occurrence of an event, such as a deadline in the case, and communicated to a client, e.g., a client computer. See Specification [19] and Fig. 1. The method comprises storing data and documents related to the case and, upon receiving the signal and identifying a rule associated with the event and a first rule related to the case, generating a message using the first rule, "the message identifying an action to be performed in response to the event and identifying a date associated with the action" (Specification [19]).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method of generating a message for a first intellectual property case, the method comprising:
storing information related to a plurality of intellectual property cases on a computer-readable

¹ Our decision will make reference to the Appellant's Appeal Brief ("Br.," filed Dec. 26, 2006) and the Examiner's Answer ("Answer," mailed Mar. 9, 2007).

medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case;

receiving a signal indicating occurrence of an event related to the first intellectual property case;

responsive to receiving the signal, identifying one or more rules associated with the event;

identifying at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium;

generating at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action; and

communicating the at least one message to a first designated client system.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Kamarei	US 6,859,806 B1	Feb. 22, 2005
Lee	US 7,016,852 B1	Mar. 21, 2006

Appeal 2008-1228
Application 09/996,341

The following rejections are before us for review:

1. Claims 1, 2, and 5-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kamarei.
2. Claim 3 is rejected under 35 U.S.C. § 103(a) as unpatentable over Kamarei.
3. Claims 21-26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kamarei and Lee.

ISSUES

The issues before us are whether the Appellant has shown that the Examiner erred in rejecting claims 1, 2, and 5-20 as anticipated by Kamarei; claim 3 as unpatentable over Kamarei; and, claims 21-26 as unpatentable over Kamarei and Lee. These issues turn on whether Kamarei describes the step in claim 1 of:

storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. The storing step of claim 1 reads: “storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case.”
2. The storing step of claim 1 describes storing information. The information is characterized as being related to intellectual property cases.
3. The information is stored on a computer-readable medium. Since computer-readable mediums store information in the form of data, the information is stored on the computer-readable medium as data.

4. The Specification does not give the claim phrase “computer-readable medium” an explicit definition but rather discloses a range of conventional devices for storing data:

[40] Fig. 1 is a simplified block diagram of a distributed system 10 that might incorporate an embodiment of the present invention.

[47] ... As shown in Fig. 1, IP data processing system 100 includes server 101 (e.g., a Web server), a data storage repository such as database 106,

[52] The computer systems depicted in Fig. 1 may be of the form depicted in Fig. 2. Fig. 2 is a simplified block diagram of a computer system 200 according to an embodiment of the present invention. As shown in Fig. 2, computer system 200 includes at least one processor 202 that communicates with a number of peripheral devices via a bus subsystem 204. These peripheral devices may include a storage subsystem 206, comprising a memory subsystem 208 and a file storage subsystem 210,

[57] ... File storage subsystem 210 provides persistent (non-volatile) storage for program and data files, and may include a hard disk, a floppy disk drive along with associated removable media, a Compact Disk Read Only Memory (CD-ROM) drive, an optical drive, removable media cartridges, and other like storage media.

5. Accordingly, the claim phrase “computer-readable medium” means, for example, a hard drive of a computer.

6. According to the storing step of claim 1, the data is stored in a “case data unit.”
7. The Specification defines “case data unit” as follows:

[62] A case data unit stores data and/or a collection of electronic documents (or references to the electronic documents) that are related to a particular case, e.g., a patent application in a particular country.

[63] The case data unit may be implemented as a data structure, a file, a database, or any other structure capable of storing data and/or documents.
8. Accordingly, the claimed phrase “case data unit” means, for example, a database.
9. According to claim 1, the case data unit stores data “related to the first intellectual property case and one or more documents related to the first intellectual property case.”
10. The Specification defines the type of information and the types of documents the case data unit can store:

[48] ... The information in database 106 may include draft and completed invention disclosures, draft and completed patent application documents, draft and completed prosecution filings (e.g., amendments), information about discussions pertaining to invention disclosures and patent applications, patent and patent application status information, prior art publications, office actions, assignment papers, other forms and papers filed in or generated by a patent office, etc.

[64] The documents stored in or referred to by a case data unit may include a variety of documents of different document types. Specific examples of documents types include an invention disclosure, a filed patent application, patent drawings, ... forms, image files, ...

11. Accordingly, images are a type of document, related to a first intellectual property case, the case data unit stores.
12. Thus, claim 1 describes storing information and at least one document, such as an image, in a “case data unit,” or database, on a “computer-readable medium,” such as a hard drive.²

The prior art

13. Kamarei is directed to a computer based method and system for managing dockets for legal cases.
14. Kamarei describes a database which contains information related to legal cases. (See col. 6, l. 49) (“Case Listing Database”) and Fig. 1, element 20.
15. Kamarei further describes the database as a means for bringing about documents. (See col. 11, ll. 40-52):

² We construe claim 1 as requiring the case data unit to store information *and* at least one document. The Examiner suggested that the storing step could be construed to require the case data unit to store only data *related* to at least one document, rather than the document itself. (Answer 15). That construction is negated by dependent claim 24 (24. The method of claim 1, further comprising: scanning a paper to produce a scanned document in a computer readable format; wherein *storing one or more documents comprises storing the scanned document*.). Emphasis added.

Automated Document Generation and Filing System

In a preferred embodiment, the Host Server System further comprises of a document generation step wherein any one or combination of the following documents are created by the host server system using information contained in the Case Listing Database 20; legal documents, action prompt reports, action prompt due date reports, client system defined forms, and client system defined letters. In an embodiment the documents are prepared automatically as a result of a time criteria. The time criteria are optionally defined by the client system in the host server system and optionally include a set date.

16. Lee relates to a system and method for managing fees associated with the processing and handling of intellectual property transactions.

PRINCIPLES OF LAW

Anticipation

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a

person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18-19.

ANALYSIS

Rejection of claims 1, 2, 5-20 under 35 U.S.C. § 102(b) as being anticipated by Kamarei

The Appellant argued claims 1, 2, and 5-20 as a group (Br. 7-10). We select claim 1 as the representative claim for this group, and the remaining claims 2 and 5-20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007). Claim 1 is reproduced *supra*.

The Appellant's sole argument (Br. 7-10) is that Kamarei does not describe the claim 1 step of:

storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case, wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case.

Based on the broadest reasonable construction of claim 1 in light of the Specification as it would be interpreted by one of ordinary skill in the art, the step in question is drawn to storing information and at least one document in a case data unit, such as a database, on a computer readable medium, such as a hard drive. (FF 12). Accordingly, the Appellant is arguing that Kamarei fails to describe storing information and a document in, for example, a database on a hard drive. (We recognize that the

information in the claim 1 method relates to intellectual property cases. But a distinction between information related to intellectual property cases and information related to another subject is a distinction grounded on nonfunctional descriptive material. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Accordingly, we agree with the Examiner (Answer 13-14) that the limitation in claim 1 that relates the information to be stored to intellectual property cases is not patentably consequential.

There are two aspects to this argument: whether Kamarei describes (a) a database on a computer readable medium and (b) using that combination to store information and a document.

The first aspect to the argument is not in dispute. Kamarei describes a database on a computer readable medium. Kamarei is replete with disclosures of databases; most notably, Kamarei's method comprises operating a "Case Listing Database." (FF 15). Since databases cannot operate apart from the computer readable medium that they are on, in operating a database Kamarei necessarily, and thus inherently, describes a computer readable medium for holding the database.

On the question of whether the Kamarei uses its database to store both information and documents, the Examiner directed the Appellant's attention to disclosures at col. 5, ll. 19-31; col. 6, l. 49 ("Case Listing Database"); col.

10, ll. 6-10; Fig. 6; col. 8, l. 45 – col. 9, l. 2; col. 9, l. 32 – col. 10, l. 9; col. 10, ll. 64-67; col. 11, ll. 40-67; and, col. 13, ll. 55-63. Answer 3-4. The Appellant contends that none of these disclosures describe a database used in the manner claimed. “Specifically, the final Office action identifies nothing in Kamerei [sic] that even remotely teaches the storage of such documents, let alone the storage of such documents in a case data unit that stores data related to the first intellectual property case and one or more documents related to that case, as recited by the independent claims.” Br. 9.

We disagree with the Appellant. We have carefully reviewed Kamarei and the disclosures cited by the Examiner and find that Kamarei discloses using its database to store both information and documents. We reach this finding based on the disclosure in Kamarei at col. 11, ll. 40-52. (FF 15). That passage indicates that Kamarei’s method comprises a document generation step where “any one or combination of the following documents are created using information contained in the Case Listing Database 20.” “[T]he following documents” includes, for example, “legal documents.” One of ordinary skill would understand Kamarei’s database to operate conventionally and that would include bringing about documents from information contained in a database that is in the conventional forms of either data or documents. One having ordinary skill in the art would understand the disclosure of Kamarei to expressly disclose bringing about the particular documents disclosed by getting information in the form of a

Appeal 2008-1228
Application 09/996,341

document or data from a database. As such, Kamarei reads on the storing of documents and information in the claimed case data unit.

Accordingly, we are not persuaded by the Appellant's argument as to error in the rejection.

Rejection of claim 3 under 35 U.S.C. § 103(a) as unpatentable over Kamarei

The Appellant argued against the rejection of claim 3 for the same reasons used to argue against the rejection of claim 1. (Br. 10). Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claim 3.

The legal standard for determining obviousness set forth in the brief appears to be an accurate reflection of the law on obviousness at the time the brief was filed. (Br. 10). However, *KSR*, which issued after the filing of the Brief, has since clarified the law on obviousness. The legal standard for determining obviousness is now more flexible. We direct *KSR* to the Appellant's attention for future reference.

Rejection of claims 21-26 under 35 U.S.C. § 103(a) as unpatentable over Kamarei and Lee

The Appellant argued against the rejection of claims 21-26 for the same reasons used to argue against the rejection of claim 1. (Br. 10-11). Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claims 21-26.

Appeal 2008-1228
Application 09/996,341

CONCLUSIONS OF LAW

The Appellants have not shown that the Examiner erred in rejecting claims 1, 2, and 5-20 under 35 U.S.C. § 102(e) as being anticipated by Kamarei; claim 3 under 35 U.S.C. § 103(a) as unpatentable over Kamarei; and, claims 21-26 under 35 U.S.C. § 103(a) as unpatentable over Kamarei and Lee.

DECISION

The decision of the Examiner to reject claims 1-3 and 5-26 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a) (1)(iv) (2007).

AFFIRMED

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834